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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77684321
Applicant	Johnson & Johnson
Applied for Mark	BEST FOR BABY
Correspondence Address	MELISSA S DILLENBECK DRINKER BIDDLE & REATH LLP 191 NORTH WACKER DRIVE STE 3700 CHICAGO, IL 60606 UNITED STATES melissa.dillenbeck@dbi.com, nancy.martinez-curtin@dbi.com
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Filer's Name	Nathan A. Pollard
Filer's e-mail	dctrademarks@dbi.com, tmdocket@dbi.com, melissa.dillenbeck@dbi.com, nathan.pollard@dbi.com, michelle.junkas@dbi.com
Signature	/Nathan A. Pollard/
Date	09/15/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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**TRADEMARK:** BEST FOR BABY  
**APPLICANT:** Johnson & Johnson  
**SERIAL NO.:** 77/684321  
**FILED:** March 5, 2009

**BRIEF OF APPELLANT**

Applicant hereby appeals from the Examining Attorney's October 19, 2013 final refusal to register the subject trademark and respectfully requests that the Trademark Trial and Appeal Board reverse the Examining Attorney's decision.

**Issue on Appeal**

Whether a point-of-sale coupon submitted by Applicant in support of its application to register BEST FOR BABY is an appropriate display specimen under the Section 1127 of the Lanham Act, and thus whether it was improperly refused under Section 904.03(g) of the Trademark Manual for Examination Procedure (T.M.E.P.).

**Applicant's Argument**

I. **Introduction**

It is well established that point-of-sale material demonstrates use of a trademark, and serves as a proper specimen. This is not controversial; indeed, the T.M.E.P. extensively describes the rationale and history of the practice, and the word "display" is itself used in Section 1127 of the Lanham Act as proper evidence of use. Thus, it should not surprise that the logic set forth in the T.M.E.P. is dispositive as to what qualifies as a

“display” specimen: “[t]hese items must be designed to catch the attention of purchasers and prospective purchasers *as an inducement to make a sale.*” T.M.E.P. 904.03(g) (emphasis added).

Applicant submitted a point-of-sale coupon as a specimen for the BEST FOR BABY mark for “Toiletries, namely, baby bath skin cleansers and washes, and baby lotion” in Class 3. This coupon by its visible terms can only be used at the point-of-sale, and indeed is actually dispensed to the consumer at the point-of-sale itself. It was designed to catch the attention of purchasers and prospective purchasers; that much is self-evident. But more critically (and perhaps more than any other kind of specimen imaginable) a coupon is designed to act as a direct inducement to make a sale. That is, in fact, the only point of a coupon; it serves no other purpose. Thus, a point-of-sale coupon is exactly the type of specimen that should be accepted as evidence of use.

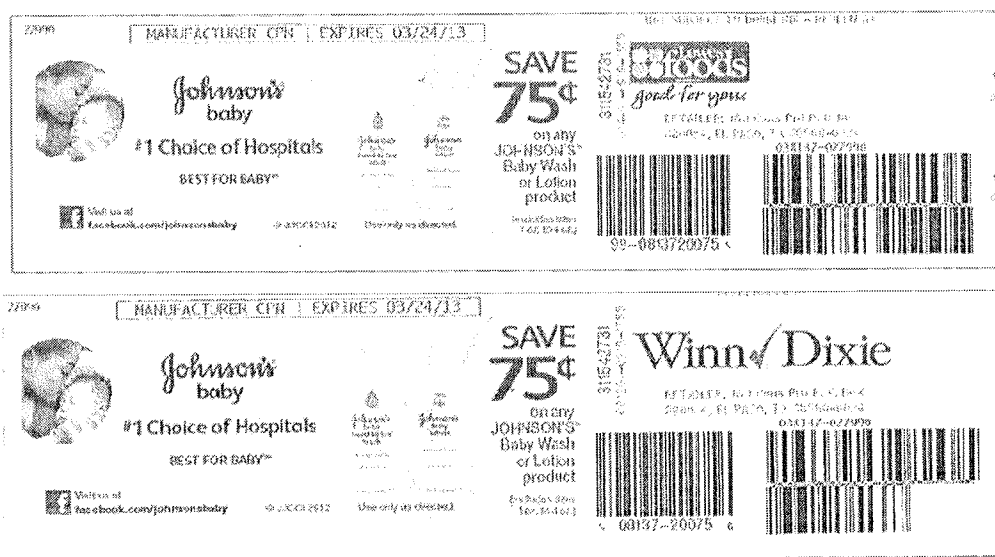
Yet, contrary to the explicit requirements of the T.M.E.P. and the Lanham Act, the Examining Attorney rejected the specimen and refused registration of Applicant’s mark, arguing that Applicant’s specimen is not acceptable to show use in commerce because it consists of “advertising” materials. Specifically, the Examining Attorney stated, “the specimen is not acceptable ... because it consists of \$.75 coupons for use at the Winn Dixie and the Lowes grocery stores that feature a picture of the goods, namely a bottle of baby lotion and the words ‘BEST FOR BABY,’ but fails to show the proposed mark on the actual goods or packaging, or displays associated with the actual goods at their point of sale.” This rejection was wrong as a matter of law and policy; moreover, this rejection also failed to recognize the way that consumers use coupons in retail

environments. It is well settled that the acceptability of specimens of use must be considered in the context of the marketplace. *See, e.g. In re Dell*, 71 U.S.P.Q.2d 1725, 1727 (T.T.A.B. 2004). No such consideration took place.

In sum, a point-of-sale coupon clearly meets each of the relevant criteria to be considered a display associated with the goods under the Lanham Act. Applicant's specimen is as much a piece of point-of-sale material as a banner, shelf-talker, window display, catalog, trade show booth, or menu – each of which have been found to be acceptable specimens for goods. *See* T.M.E.P. 904.03(g). The Board should reverse the Examining Attorney's rejection and permit the application to proceed to registration.

## II. A Point-Of-Sale Coupon is An Acceptable Display Associated with the Goods

Applicant's point-of-sale coupon prominently bears the mark BEST FOR BABY. Directly below is an image of the specimen at issue which has been inserted for the Board's convenience.



Applicant's point-of-sale coupon is associated directly with the goods offered for sale. The specimens at issue are coupons available at the store itself, generated and provided to the customer at the cash register. Any argument that the specimen coupons are not available at the point-of-sale is negated by the fact that the coupons are actually provided to the consumer in the very store in which they can be redeemed – *at the point-of-sale*. One could feasibly receive the coupon after purchase and immediately step back into the store and purchase the product discounted by the coupon. And the coupon is designed to be used as part of the purchasing process itself – it is the instrument through which a purchase is induced. It is difficult to imagine a more direct connection to the purchasing process than a point-of-sale coupon.

### III. “Displays” Are Interpreted Broadly

Specimens with a far more distant nexus to the purchasing process than a point-of-sale coupon have been found to be acceptable displays. It is beyond question that Applicant's point-of-sale coupon is at least as much a “display associated with the goods” as a catalog, a trade show booth, or an infomercial, each of which have been deemed acceptable specimens for goods. For instance, the Board in *Dell* states that an Examining Attorney should accept any “catalog or similar specimen as a display associated with the goods, provided: (1) it includes a picture of the relevant goods; (2) it shows the mark sufficiently near the picture of the goods to associate the mark with the goods; and (3) it includes the information necessary to order the goods ....” 71

U.S.P.Q.2d at 1727; *see also Lands' End, Inc. v. Manback*, 24 U.S.P.Q2d 1314 (E.D.Va. 1992)

(catalog containing mark, picture of the goods, and corresponding description constitutes proper display associated with goods). The coupon submitted by Applicant meets each of these requirements: It includes an image of the relevant goods, it shows the mark BEST FOR BABY near the image of the goods, and specifically lists the retailer where the items can be purchased, as well as the amount of the discount available at the time of purchase.

This reasoning also follows the Board's decision in *In re Shipley Co.*, 230 U.S.P.Q. 691 (T.T.A.B. 1986), where a specimen showing a mark at a trade show booth was deemed to be an acceptable "display associated with the goods" because the trade show booth was a sales counter for applicant's products, even though the chemicals being sold were not physically present at the booth. The Board allowed the specimen, finding that the mark was used at the point-of-sale – the location where the goods could be ordered or purchased, even though the goods identified by the mark were not physically present. *Id.* Just as in *Shipley*, Applicant's point-of-sale coupon specimen shows the mark being used *at the point of sale*, since the coupon is printed at the retailer where the product could be ordered or purchased, and can only be used at the point of sale.

Not only did the Board find that a trade show display was acceptable as a display associated with the goods, it also held that *an infomercial* that created an association between the mark and the goods was a proper specimen for goods in *In re Hydron*, 51 U.S.P.Q.2d 1531 (T.T.A.B. 1999). In *Hydron*, the Board found the infomercial to be "a basis upon which a customer can identify the products he or she wants to

purchase, make the decision to purchase them, and place the order.” *Id.* at 1534.

Applicant’s point-of-sale coupon clearly meets these same specifications. First, the customer can identify the products he or she wants to purchase through viewing the image of the goods shown on the coupon. The consumer can make the decision to purchase those goods, and then pull the item from the retailer’s shelf and purchase the goods.

In addition, Applicant’s coupon specimen is at least as much a display associated with the goods as a window display or shelf-talker, other items previously acknowledged to be acceptable point-of-sale displays for goods. *See, e.g., Roux Laboratories, Inc. v. Clairol Incorporated*, 427 F.2d 823, 830 (C.C.P.A. 1970) (Clairol’s use of HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE on window and counter displays at salons found to be acceptable displays associated with goods). If a consumer can see a counter display or shelf-talker at a retailer, consider a purchase, and take the item to the cashier to purchase the goods, a consumer can certainly obtain a coupon at a retailer, consider a purchase, and then go to the store to purchase the goods *with the coupon itself*.

#### IV. A Point of Sale Coupon Provides the Means to Purchase The Goods

The Examining Attorney cryptically states that the coupon is not point-of-sale material because it does not provide the means for purchasing the goods. (Office Action, p. 2). “[T]he coupon is available for use on a number of Johnson’s products, not one particular product. ... The coupons are a discount voucher, not an invitation to

order/purchase,” the Trademark Examiner added. In fact, Applicant’s coupon specimen provides exactly a means for purchasing the goods from information on the coupon. It does so by specifically stating the store location where the goods are for sale and where the coupon can be redeemed, and then provides a discount on that sale. Just as a banner or shelf-talker encourages a customer to make a purchase and provides information for the consumer to do so, Applicant’s coupon offers potential consumers everything they need to know to make a purchasing decision and motivates them to purchase Applicant’s goods. The fact that the coupons offer a discount on a product does not negate their invitation to purchase products.

Furthermore, in every situation where a display associated with the goods was found acceptable, the consumer, who then has the means to purchase the goods, must still take the additional step of making the purchase. For instance, the *Lands End* court explained that in the catalog as a display, “a customer can...make a decision to purchase by filling out the sales form and sending it in or calling in a purchase by phone.” 24 U.S.P.Q.2d at 1316. If a catalog has a phone number or website address, the consumer still has to make the phone call or visit the website to purchase the item. In the exact same way, a coupon lists the retailer where the consumer can purchase the item, which becomes the means for purchasing the goods. The consumer then can take the next step, and go to the retailer to make the purchase. In this way, the coupon does provide the means for ordering or purchasing the goods.

In fact, the specimens associated with the goods do not need to even be physically proximate to the goods themselves at the point of sale. The PTO’s reviewing

court of appeals has specifically rejected the assertion that the display of the mark must be in physical proximity to the goods to be associated with such goods. *In re Marriott Corp.*, 173 U.S.P.Q. 799, 800 (C.C.P.A. 1972). Rather, “‘association with the goods’ is a relative term amenable to proof,” *id.*, and an acceptable display appears at the point of sale where the consumer consummates the purchasing decision. The coupon’s lack of physical proximity to Applicant’s goods at the retailer is immaterial, since the coupon must be paired with the goods and surrendered at the time of checkout – the point of sale where the consumer purchases the item.

Finally, while the coupon bears the mark prominently and shows an association between the mark and the goods, the coupon also garners a consumer’s attention to induce a sale. Indeed, a coupon’s primary purpose is to catch the attention of prospective purchasers, give them information relevant to a purchasing decision, and ultimately consummate a sale. Applicant’s point-of-sale coupon does so by displaying Applicant’s Goods with Applicant’s Mark, offering potential purchasers a discount, and instructing purchasers to redeem the coupon and purchase the product at a specified retailer within a specific time frame. Applicant’s point-of-sale coupon meets all of the relevant criteria of a “display associated with the goods,” and the Examining Attorney’s rejection is contrary to the proper legal standard.

The applicable logic is even visible in the instances where a specimen is inadequate. Unlike the catalogs recently rejected in *In re U.S. Tsubaki, Inc.*, Serial No. 85267349 (March 7, 2014), for example, the point-of-sale coupons submitted by Applicant require no other information in order to effectuate and incentivize the sale –

the coupons are dispensed in the very place they will be used as part of the sale itself. The Board in that proceeding took judicial notice of the definition of “Advertising” and concluded that a point-of display specimen must be “calculated to consummate a sale.” Id. at 16 (*quoting In re Bright of America, Inc.*, 205 USPQ 63, 71 (TTAB 1979)). Unlike the minimalist catalog in *Tsubaki*, the entire point of a coupon is to consummate a sale, at the point of sale; no other information is required.

V. Changes In The Retail Market Demonstrate Why Coupons Are Proper Specimens

It is well settled that the acceptability of specimens of use must be considered in the context of the marketplace. *See, e.g. In re Dell*, 71 U.S.P.Q.2d 1725, 1727 (T.T.A.B. 2004). Moreover, as one of the preeminent authorities on trademark law has noted, “over time, the category of unacceptable use in “mere advertising” shrunk and the category of acceptable uses expanded.” J. Thomas McCarthy, 2 McCarthy on Trademarks and Unfair Competition § 16:30 (4th Ed.). Thus, while the specimens at issue should have been accepted under any current understanding of a coupon, the notion that coupons are not active parts of the purchasing process also fails to take into account changes in how coupons have been used and experienced in recent years. Point-of-sale coupons can be (as in the case at hand) dispensed at the retail location itself, at the register, in response to a purchase. They can also be purely digital, using geo-location and geo-targeting technology to recognize when a customer is in or near a store and serving them a relevant coupon to use at that very moment. Consumers can even look up coupons on their smartphones – while in a store – and use them to

purchase products immediately. The notion that coupons are “mere advertising” is belied by our own daily experience with the retail marketplace.

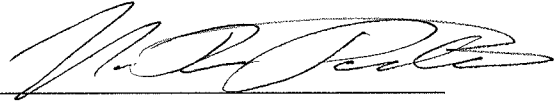
The very process of shopping has changed dramatically, with the increase of digital platforms and delivery services. The mere act of shopping for groceries can no longer be the detached process it once was. Companies transmit or offer coupons before, during and, after store visits (if one even visits a physical store). The definition of what is a coupon has evolved dramatically in the past few years and with it so too should our understanding of where a point of sale occurs.

Each of these new technologies tie point-of-sale coupons even closer to the purchasing process, and render them integral to the consumer experience of a brand. The Examining Attorney’s rejection of a point-of-sale coupon does not take this into account – and if affirmed such a holding will create significant uncertainty in the future as technology continues to define point-of-sale coupons in ever more flexible ways.

### **Conclusion**

For the reasons set forth above, Applicant submits that its mark is entitled to registration because the submitted specimen is a proper display associated with Applicant’s goods demonstrating use of Applicant’s Mark in commerce. Accordingly, Applicant respectfully requests that the Board reverse the Examining Attorney’s decision refusing registration of Applicant’s mark.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. S. Cahr', written over a horizontal line.

Darren S. Cahr

Melissa S. Dillenbeck

Nathan A. Pollard

Attorneys for Applicant

DRINKER BIDDLE & REATH LLP

191 North Wacker Drive, Suite 3700

Chicago, Illinois 60606

(312) 569-1000

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